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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,491	01/09/2002	Hidehei Kageyama	No. 50	2851

7590 01/15/2003

McGinn & Gibb, PLLC
Suite 200
8321 Old Courthouse Road
Vienna, VA 22182-3817

EXAMINER

PRUNNER, KATHLEEN J

ART UNIT

PAPER NUMBER

3751

DATE MAILED: 01/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 10/040,491 Applicant(s)

Kageyama et al.

Examiner Kathleen J. Prunner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Jun 18, 2002

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on Jan 9, 2002 is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 & 4

6) Other:

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DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “operating part for causing said lead (writing medium) feeding mechanism to feed the lead (writing medium)”, as called for by claims 1 and 10, must be shown or the feature(s) canceled from the claims. No new matter should be introduced or it will not be entered. A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. Applicant is required to submit a proposed drawing correction **in reply to this Office action** in order to avoid abandonment of the application. Any proposal by the applicant for amendment of the drawing to cure defects **MUST** be embodied in a **SEPARATE LETTER to the Draftsman**. See MPEP §608.02(r). The objection to the drawings will not be held in abeyance.

Specification

3. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and **should include that which is new in the art** to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making

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and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract **should be in narrative form** and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims**, such as "means" and "said," **should be avoided**. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and **should not repeat information given in the title**. It should avoid using phrases which can be implied, such as, "The disclosure concerns", "The disclosure defined by this invention", "The disclosure describes", etc.

5. The abstract of the disclosure is objected to because: **(A)** page 14 contains superfluous matter, i.e., the title of the invention; **(B)** it fails to include or point out that which is new in the art;

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(C) it is not in narrative form; (D) it uses the form used in patent claims; and (E) it repeats information given in the title. Correction is required. See MPEP § 608.01(b).

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The claimed subject matter which lacks such antecedent basis is as follows: "holding portions" and "holding portions for holding the lead (writing medium) being provided in at least two positions between said lead (writing medium) feeding mechanism and a tip end of said barrel spacedly in the axial direction", as called for by claims 1 and 10. Correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 3 and 12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "the maximum static friction force generated between the rib 50g and inner peripheral face of the tip end member 14 is set to be larger than a sum of the maximum static friction force generated between the rib 50f and the lead" (note lines 4-8 on page 7), does not reasonably provide enablement for "a maximum static friction force generated between the lead (writing medium) holder and an inner peripheral face of said barrel is set to be larger than a maximum static friction force generated between the holding portions and the lead (writing medium)", as called for by claims 3 and 12. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 6-9, 15-18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Regarding claims 6 and 15, the phrase "at least one blade, as at least one of said holding portions" renders the claims indefinite because it is unclear whether the limitations "at least one blade" and "as at least one of said holding portions" are part of the claimed invention.

12. Regarding claims 7 and 16 (including claims 8 and 17 which depend therefrom), the phrase "a rib, as at least one of said holding portions" renders the claims indefinite because it is unclear whether the limitations "a rib" and "as at least one of said holding portions" are part of the claimed invention.

13. Claims 9 and 18 contain terms lacking proper antecedent basis. The claims recite the limitations "said holding portions which is forwardly positioned" in lines 1-2 and "said holding portions which is rearwardly positioned" in line 4. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 20 is indefinite since it is unclear as to how "a consumed writing medium", i.e., a writing medium that has been completely used up or done away with completely, can be "held by the blade".

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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16. Claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Kanari et al. Kanari et al. disclose a mechanical pencil having all the claimed features including a barrel (constituted by main body 20 and mouthpiece 32), a lead feeding mechanism (note lines 44-48 in col. 3) disposed in the barrel to tighten and feed a lead 22, an operating part (constituted by the knocking) for causing the lead feed mechanism to feed the lead 22 (note lines 59-63 in col. 3), and holding portions 52 for holding the lead 22 being provided in at least two positions between the lead feeding mechanism and a tip end of the barrel spacedly in the axial direction (note Figs. 1, 3, 4 and 7A-C, and lines 48-53 in col. 4). With respect to claims 2 and 11, Kanari et al. also disclose a lead holder 36 having a through hole 40, through which the lead 22 penetrates, being provided closer to the tip end than the lead feeding mechanism side in the barrel 20, 32 and the holding portions 52 (note Figs. 2, 4, 9A and 9B). With respect to claims 3 and 12, although Kanari et al. fails to describe the static friction force used, the maximum static friction force generated between the lead holder 36 and the inner peripheral face of the barrel 20, 32 is inherently larger than a maximum static friction force generated between the holding portions 52 and the lead 22 in order for the mechanical pencil to function properly. With regard to claims 4 and 13, Kanari et al. further discloses that the lead holder 36 has a body (note Fig. 3) and an outside cylinder 50 provided concentrically on an outside of the body and being formed with a rib 44 (note Fig. 3) projecting in an outside diameter direction to come into contact with an inner peripheral face of the barrel 20, 32. With regard to claims 5 and 14, Kanari et al. additionally disclose that the outside cylinder 50 has a slit 78 (note Fig. 8A) formed in a portion of the outside cylinder in which the rib 44 of the outside cylinder is absent. With respect to claims 6 and 15, Kanari et al. also disclose that the lead holder 36 has a body being formed of at least one blade 74 (note Fig. 8A and lines 58-62 in col. 4) projecting in an inside diameter direction in a front end part of the body to come into contact with the lead 22. With respect to claims 7 and 16, Kanari et al. further disclose that the lead holder 36 has a body being formed with a rib constituted by each

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lead holding portion 52 (note Fig. 3) projecting in an inside diameter direction in a rear end part of the body to come into contact with the lead 22. With regard to claims 8 and 17, Kanari et al. additionally disclose a slit 78 (note Fig. 8A) formed in a portion in which the rib is absent at the rear end part of the body. With respect to claims 9 and 18, Kanari et al. further disclose that one of the lead holding portions 52 is forwardly positioned and another one of the lead holding portions 52 is rearwardly positioned (note Fig. 3). With regard to claim 19, Kanari et al. additionally disclose that the holding portions can constitute a blade 74 and a rib 52 in the case when the lead holder is formed integrally with the slider/outside cylinder 50,44 (note Figs. 3 and 8A, and lines 58-62 in col. 4). With respect to claim 20, Kanari et al. also disclose that one of the lead holding portions is forwardly positioned and another one of the lead holding portions is rearwardly positioned (note Fig. 3).

Conclusion

17. The Examiner is advising attorneys to FAX any response due to Office actions. The U. S. Patent and Trademark Office (USPTO) is experiencing major delays in matching up papers that were mailed. Due to the Anthrax issue, any mail sent to the USPTO is automatically sent to an irradiation center in Virginia. It has been found that the irradiation process makes papers too brittle to handle. Therefore, the irradiation center has to further copy each paper. The originally filed irradiated papers are then placed in a sealed envelope and put in the associated file. After this irradiation process, the "papers" are then sent to the Office where they are matched with the file. This entire procedure causes months in delays due to the quantity of mailed received. Therefore, it is suggested that any response be sent by FAX especially if a time limit is critical. The FAX number for the technical center where this file is located is given in the paragraph below.

18. Any inquiry concerning this communication from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044. Although the examiner

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participates in the maxi-flex program, she can usually be reached Monday through Friday from 5:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson, can be reached on 703-308-2580. The FAX phone number for the organization where this application is assigned is 703-308-7766.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0861.



Kathleen J. Prunner:kjp

January 8, 2003



DAVID J. WALCZAK
PRIMARY EXAMINER